

FACSIMILE COVER SHEET

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Date: 6 May 2003

To: John Doll
Director, Technology Center 1600
US Patent and Trademark Office
Tel. No. 703-308-4205
Fax: 703-746-5006

Subject: USSN 09/132,799
Our Ref.: Beiersdorf 514.1-HCL

From: Howard C. Lee

Comments: Filing of: Petition of Finality of Requirement of Restriction (3 pgs.)

If you have any questions or need further information, please contact us.

You should receive 4 pages including this cover sheet.

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Beiersdorf 514.1-HCL
6713-Dr. Wi-ar**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : SCHÖNROCK et al.
SERIAL NO. : 09/132,799
FILED : 13 August 1998
FOR : COSMETIC OR DERMATOLOGICAL PREPARATIONS COMPRISING
OLIGOPEPTIDES FOR LIGHTENING THE SKIN OF AGE MARKS
AND/OR PREVENTING TANNING OF THE SKIN, IN PARTICULAR
TANNING OF THE SKIN BY UV RADIATION
ART UNIT : 1654
EXAMINER : Michael Borin

6 May 2003

Attn: John Doll
Hon. Commissioner of Patents
Washington, D.C. 20231

PETITION OF FINALITY OF REQUIREMENT OF RESTRICTION UNDER 37 CFR § 1.144

SIR:

In response to the finality of the restriction and election of species requirement issued by the examiner in Paper No. 7, dated 24 February 2000, please accept this petition to reconsider the restriction requirement (especially the election of species requirement) of Paper No. 5, dated 26 May 1999 and the denial of the original petition of finality of requirement of restriction under 37 CFR 1.144 sent on 13 January 2003.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REQUEST FOR RECONSIDERATION**Review of "Discussion" Section from Petition Decision**

In the petition decision of 19 March 2003, the Director wrote:

"Applicants argue that it is unclear why longer chain acyl derivatives of VVRP are considered patentably distinct species, and that the examiner did not provide any reason. ***This argument is not persuasive because it is applicant's burden to show that the species are not patentably distinct.*** As stated in the first Office action on the merits, 'Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.' ***Absent any such evidence or admission, the examiner's position is not improper.***"

However, it is respectfully presented that adhering to such a position improperly absolves the PTO of their initial burden of proof in establishing that their actions are proper which is contrary to MPEP 816 - "The particular reasons relied upon by the examiner for holding that the invention as claimed are either independent or distinct should be concisely stated. ***A mere statement of conclusion is inadequate.***"

Moreover, although not specifically referenced in the previous petition, it is unclear how searching C₂-C₃₀ alkyl constitutes an undue burden upon the office when C₁ (acetyl) is being searched. (see MPEP 803 - "If the search and examination of an entire application can be made without serious burden, ***the examiner must examine it on the merits***, even though it includes claims to independent or distinct inventions.").

As a reminder, the election of species requirement of Paper No. 5 was "...directed to a plurality of disclosed patentably distinct species of peptide monomers and their homo- and hetero-dimers, trimers and tetramers." There is no mention of an additional election requirement (i.e. specifying a particular alkyl chain length) within one of these distinct species (applicants elected a hetero-tetramer).

For the reasons given above, the applicants' respectfully request reconsideration of petition decision of 19 March 2003.

Closing

A favorable decision on this petition is respectfully requested. If any further information is needed, please feel free to contact the undersigned at the telephone number below.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Petition of Finality of Restriction Requirement under 37 CFR 1.144 (3 pages total), is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **6 May 2003**

By: 

Vilma L. Fernandez